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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,660	07/12/2001	Valerie Jeanne-Rose	05725.0926-00	2004
22852	7590	07/28/2003		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT 1615	PAPER NUMBER

DATE MAILED: 07/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b> <i>File Copy</i>	Applicant No.	Applicant(s)
	09/902,660	JEANNE-ROSE ET AL.
	Examiner	Art Unit
	JYOTHSNA A VENKAT	1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 May 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4, 7, 10-24 and 38-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 7, 10-24, and 38-55 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

Receipt is acknowledged of amendment filed on 5/6/03. Claims 50-55 are added as per applicant's amendment dated 5/6/03. Claims 1-4, 7, 10-24, and 38-55 are examined to the extent it reads on the elected group where the metal precursor is formula IB and the metal M is silicon.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 10-24 and 38-55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to silicon covalently bonded to three oxygen atoms and one R group which is "**cosmetically active group**". The specification defines at paragraph bridging pages 7-8 as the following. The group can be colorant group. There is no structure given to this colorant group. **The specification gives no guidance to one of ordinary skill in the art the attachment of this colorant to the silicon atom.** The next choice is a photo chromic group. The specification does not define the compound in this category. The

same is true for all the choices recited at page 8. The specification defines one of the choice as “*group for promoting adhesion to keratin materials such as amide, urethane, urea, hydroxyl, carboxyl, amino acid or polypeptide group*”. Note all the groups recited for this Choices are functional groups. The functional groups includes plethora of compounds which has this functional moieties.

The expression “cosmetically active group” without i.e. partial or complete structure does not convey to one of ordinary skill in the art that applicants were in possession of the claimed subject matter. The functional language recited without any correlation does not meet the written description requirement for the expression cosmetically active group as one of ordinary skill in the art could not recognize or understand the structure from the mere recitation of the function. Claims employing functional language at the point of novelty, such as applicants’, neither provide those elements required to practice the inventions, nor “inform the public” during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression represents only an **invitation to experiment** regarding possible compounds.

***Response to Arguments***

3. Applicant's arguments filed 5/6/03 have been fully considered but they are not persuasive..

Applicants point out that the fundamental inquiry is whether the specification conveys with reasonable clarity to one skilled in the art that as of the filing date sought, applicant was in possession of the invention as now claimed. Applicants argue that fundamental inquiry is satisfied because the as filed specification includes the claims that are now being rejected as

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inadequately described and because the as-filed claims clearly convey a description of the invention as claimed, the expression "cosmetically active group" complies with 35 U.S.C. 112, 1<sup>st</sup> paragraph for written description.

In response to the above argument, it is the examiners position that the expression "cosmetically active group" **lacks clarity**. See the 112, 2<sup>nd</sup> paragraph rejection. The specification defines the groups without clearly naming the groups in each category. For example the specification defines one of the choices as "colorant group". However the specification does not convey with reasonable clarity to one skilled in the art the compound under "colorant group" and the attachment of this colorant group to silicon atom. The same is true for the newly added claims 50-55. The claims recite various functional groups and the specification does not convey with reasonable clarity the attachment of these functional groups to the silicon atom. Is it the functional group that is attached to the silicon atom or is it compound, which has these functional groups, attached to the silicon atom? It is the examiners position that the fundamental inquiry is not satisfied with respect to "clarity" in conveying to one of ordinary skill in the art that applicants were in possession of the subject matter with respect to "cosmetically active group".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. ~~Claims 1-3, 10-24, and 38-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.~~

The following reasons apply:

I. Claims 1, 45 and 48 recite “**cosmetically active group**” for the definition of R. Note that the formula IB is drawn to covalent structure. The metal is silicon and the silicon has three oxygen atoms. When the fourth bond is cosmetically active group the expression lacks precision and clarity. How is this” **cosmetically active group**” linked to the central silicon atom by covalent bond? The various groups recited are drawn to divergent compounds. Applicants are requested to show the reaction in such way that, in group Ib **the cosmetically active group is covalently linked to silicon**. Due to these reasons, it is the examiners position that the claims lack clarity and precision.

*Response to Arguments*

6. Applicant's arguments filed 5/6/03 have been fully considered but they are not persuasive..

Applicants argue that there is no requirement to show the bond between the metal atom M and the cosmetically active group and point out hat one of ordinary skill in the art would understand that the metal M would be bonded to the cosmetically active group.

7. In response to the above argument, it is the position of the examiner, that it is not clear to the examine the point of attachment of this group to Metal atom. **In order to complete the record, applicants are requested to show the structure which clearly explains to the examiner the point of attachment of cosmetically active group to metal atom, the point of attachment of claims 50-55 to silicon atom.**

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0,159,628 ('628).

See page 3 for the structure. See page 4 for the definition of variables . Claims 45-46 are drawn to composition and therefore anticipated by the reference.

#### ***Response to Arguments***

10. Applicant's arguments filed 5/6/03 have been fully considered but they are not persuasive.

11. Applicants argue that that claim 45 ( composition ) has been amended to recite the limitation of claim 15 and therefore the claim is not antiicipated by the reference.

12. In response to the above argument, it is the position of the examiner that the claims 45-46 are drawn to compositions and to method of use and these claims are still antiicipated by the reference. The functional language recited at the end of the claim does not carry any patentable weight as the claims are drawn to compositions and the compound is within the genus of the formula I b where in the metal is silicon.

13. *This application contains claims 1-4, 7, 10-24, and 38-55( non-elected subject matter) and claims 5-6, 8-9, and 25-37 drawn to an invention nonelected with traverse in Paper No.*

**11. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.**

**14. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is 703-308-1235.

*J Venkat*  
**HYOTHSNA A VENKAT**  
**Primary Examiner**  
**Art Unit 1615**

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July 24, 2003